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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,936	08/28/2003	Kikuo Hayashi	991334A	6093
38834 7590 10/17/2008 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER				
BROWN JR, NATHAN H				
ART UNIT		PAPER NUMBER		
2129				
MAIL DATE		DELIVERY MODE		
10/17/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/649,936

Applicant(s)

HAYASHI ET AL.

Examiner

NATHAN H. BROWN JR

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE (3) MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 95-127 and 130 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 95-127 and 130 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Examiner's Detailed Office Action

1. This Office Action is responsive to the communication for application 10/649,936, filed August 29, 2008.
2. Claims 95-127 and 130 are pending. Claim 95 is currently amended. Claims 96-127 are previously presented. Claim 130 is new.
3. After the previous office action, claims 95-127 stood rejected.

Claim Rejections - 35 USC § 112, 1st

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 95-127 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written

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description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Amended independent claim 95 recites "a user actuable controller to select outputs" which is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification provides no disclosure of "a user actuable controller", "a user controller", "a controller", or "selector". All disclosures of 'selection' are considered to be descriptions of software function only.

6. Claims 95-127 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Amended independent claim 95 recites "a user

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actuatable controller to select outputs" which is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. First, the specification provides no disclosure of "a user actuatable controller", "a user controller", "a controller", or "selector". Second, no hardware support, such as a keyboard, mouse, pointer, button, joy stick, or data glove is disclosed for "a user actuatable controller". All disclosures of 'selection' found are considered to be descriptions of software function only. Without hardware support for "a user actuatable controller" being disclosed, one skilled in the art to which it pertains, or with which it is most nearly connected, is not enabled to make and/or use the invention as claimed in claims 95-127.

7. Claim 130 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed

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invention. Independent claim 130 recites a "computer system" having a "selection device" which is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Paragraph [0028] of the specification describes FIG. 1 as showing "a block diagram of a genetic design apparatus according to the present invention" which "includes programmed components, such as a selection unit 2". Examiner considers "programmed components" such as the "selection unit" to be software only. As no hardware support for a "selection device", such as a keyboard, mouse, pointer, button, joy stick, or data glove is disclosed in the specification, Examiner considers all disclosures of 'selection' to be merely descriptions of software function.

8. Claims 130 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the

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invention. Independent claim 130 recites a "selection device" which is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Further, no hardware support for a "selection device", such as a keyboard, mouse, pointer, button, joy stick, or data glove is disclosed in the specification. Clearly, without hardware support for a "selection device" being disclosed, one skilled in the art to which it pertains, or with which it is most nearly connected, is not enabled to make and/or use the invention as recited in claim 130.

9. Claims 95-127 and 130 are rejected under 35 U.S.C. 112, first paragraph. Specifically, if the application fails as a matter of fact to satisfy 35 U.S.C. § 101, then the application also fails as a matter of law to enable one of ordinary skill in the art to use the invention under 35 U.S.C. § 112.; In re Kirk, 376 F.2d 936, 942, 153 USPQ 48, 53 (CCPA 1967) MPEP 2107.01 (IV).

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 95-127 rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Claims 95-127 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement because no hardware support for a "user actuatable controller" is disclosed in the specification in such a way as to allow one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Lacking hardware support for a "user actuatable controller", the claimed invention cannot be used as recited in claims 95-127 because user selection of the various system displays would be impossible. With 'selection' not possible the graphical user interface cannot be even partially successful as recited in claims 95-127. Therefore, claims 95-127 lack patentable utility and are considered non-statutory under 35 U.S.C. 101.

12. Claims 130 is rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Claim 130 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement because no hardware support for "a selection device" is disclosed in the specification in such a way as to allow one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention as claimed. Lacking hardware support for "a selection device", the claimed invention cannot be used as recited in claim 130 because user selection of the various system displays would be impossible. With 'selection' not possible, the "computer system" partially success for the system as recited in claim 130 is impossible. Therefore, claims 95-127 lack patentable utility and are considered non-statutory under 35 U.S.C. 101.

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Response to Arguments

13. Applicant's arguments filed August 29, 2008 have been fully considered.

Rejection of Claims 95-127 Under 35 USC §112, first paragraph

Applicant(s) argue(s):

MPEP §2107.01(IV) indicates that if the application fails, as a matter of fact, to satisfy the practical utility requirement of 35 U.S.C. §101, then the application also fails as a matter of law to enable one of ordinary skill in the art to make and use the invention under 35 U.S.C. §112, first paragraph (i.e., the "how to use prong" of §112, first paragraph). In other words, if an application has no utility, then an applicant cannot comply with § 112, first paragraph, because compliance requires a description of how to use a presently useful invention. Otherwise, an applicant would anomalously be required to teach how to use an invention that is not useful.

Examiner responds:

Examiner thanks Applicants for correcting Examiner's use of claim rejection under 35 USC §112, first paragraph, however, Applicants' amendments have introduced new issues which indicate that the application fails, as a matter of fact, to satisfy the practical utility requirement of 35 U.S.C. §101 and also fails as a matter of law to enable one of

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ordinary skill in the art to make and use the
invention under 35 U.S.C. §112, first paragraph.

Rejection of Claims 95-127 Under 35 U.S.C. §101

Applicant(s) argue(s):

MPEP §2107.01(IV) indicates that if the application fails, as a matter of fact, to satisfy the practical utility requirement of 35 U.S.C. §101, then the application also fails as a matter of law to enable one of ordinary skill in the art to make and use the invention under 35 U.S.C. §112, first paragraph (i.e., the "how to use prong" of §112, first paragraph). In other words, if an application has no utility, then an applicant cannot comply with § 112, first paragraph, because compliance requires a description of how to use a presently useful invention. Otherwise, an applicant would anomalously be required to teach how to use an invention that is not useful.

Examiner responds:

Applicants' arguments are moot based on new grounds of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s)
of rejection presented in this Office action. Accordingly,

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a).

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Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan H. Brown, Jr. whose telephone number is 571-272-8632. The examiner can normally be reached on M-F 0830-1700. If attempts to reach the examiner by telephone are

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unsuccessful, the examiner's supervisor, David Vincent can be reached on 571-272-3080. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Nathan H. Brown, Jr./
Examiner, Art Unit 2129
October 17, 2008

/David R Vincent/
Supervisory Patent Examiner, Art Unit 2129